

**REMARKS**

The above amendment with the following remarks is submitted to be fully responsive to the Office Action of June 10, 2005. Reconsideration of this application in light of the amendment and the allowance of this application are respectfully requested.

Claims 1-25 were pending in the present application prior to the above amendment. In response to the Office Action, claims 11, and 17-20 have been amended above. Therefore, claims 1-25 are still pending in the present application and are believed to be in proper condition for allowance.

Initially, the Applicants acknowledge with appreciation, the Examiner's cooperation in granting a personal interview with the Applicants' representatives on November 8, 2005, during which features of the present invention, and limitations of the cited references, were discussed in detail.

Referring now to the Office Action, claims 11-25 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for the lack of proper antecedent basis for the phrases "the shank point" and "the package". In response, claims 11 and 20 have been amended to recite "tip" instead of "point". Claims 17-19 have also amended to delete the phrase "the package". Correspondingly, in view of the amendments correcting the noted defects of these claims, the withdrawal of this rejection is respectfully requested.

Referring again to the Office Action, claims 1-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,836,372 to Shelton, in view of U.S. Patent No. 5,642,974 to Gabriel et al. or U.S. Patent No. 6,905,525 to Oswald, and Standard Specification for Driven Fasteners: American Society for Testing and Materials, F1667-95 (hereinafter "ASTM F1667 Standard"). The Applicants respectfully disagree for the reasons set forth herein below.

In particular, the Examiner notes that Shelton discloses a package of collated nails with an attachment element to temporarily attach the plurality of nails together. The Examiner accurately notes that Shelton does not disclose the material of the nails. Correspondingly, the Examiner relies upon Gabriel et al. that discloses nails for sheathing made from 1030 carbon steel wire, and/or Oswald that discloses a nail like device also made of steel.

The Examiner further correctly notes that Shelton fails to show the recited shank diameter between 0.092 to 0.148 inch, length between 1.625 to 3.00 inches, and the ratio of the head diameter to the shank diameter between 2.70 and 3.37, all of which are recited in independent claim 1. The Examiner then cites Table 36 of the ASTM F1667 Standard and identifies a nail having a length of 1.75 inches, a shank diameter of 0.113 inches, and a head diameter of 0.312 inches, which provides a ratio of the head diameter to the shank diameter is 2.76. The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the nails disclosed in Shelton to have the dimensions of the nail disclosed in Table 36 of the ASTM F1667 Standard, and presumably, also obvious to provide such a nail made of steel as disclosed in Gabriel et al. or Oswald. The Applicants respectfully disagree and contend that the Examiner has failed to establish any teachings or suggestions in the cited references, or elsewhere, to combine these references in the manner suggested to result in the invention claimed.

In this regard, the Examiner is respectfully reminded that “to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” MPEP §§ 2142 and 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (see also MPEP § 706.02(j)).

The Examiner’s rejection essentially picks critical nail dimensions from a nail that is made from a completely different material, and which has been approved for a completely different application, to summarily assert that it would be obvious to modify the dimensions of the nail of Shelton to derive the claimed invention, even though absolutely no motivation is established for doing so. The present invention as recited in independent claim 1 requires a steel nail suitable for use in a sheathing that has a specific length range and a specific shank diameter range. Claim 1 further recites a specific ratio between the head diameter of the nail to the shank diameter. The nail recited in the presently rejected claims is neither disclosed, nor rendered obvious, by the cited references in that there is absolutely no teachings or

suggestions in any of the cited references to modify the disclosed nails of Shelton, or combine these references, in the manner suggested by the Examiner. In addition, the Examiner does not establish any motivation for modifying the nails of Shelton either, but merely asserts that it would be obvious.

As specifically discussed during the personal interview, the references of record not only fail to establish any motivation to combine these references in the manner now suggested by the Examiner, but also actually teach away from any such modifications. In this regard, it should be understood by the Examiner that in the nail art, nails are generally not used interchangeably between structural applications, and non-structural applications. Instead, nails are specifically designed and approved for use in a specific application to ensure that the nails are suitable for the particular use. For instance, if a non-structural nail was utilized for a structural application, such as for sheathing, joint failure will likely occur, and associated property damage and even bodily injury possible. Evidence of this is most clearly shown in the cited ASTM F1667 Standard itself. The ASTM F1667 Standard tabulates various nails of different dimensions which are approved for use in the various identified applications specifically set forth therein.

Thus, a person of ordinary skill in the art that is seeking to utilize an approved nail for a particular application, would refer to the ASTM F1667 Standard to identify the table that sets forth the desired application, and would select a nail from the list of nails that are set forth in the table associated with the desired application. Correspondingly, the ASTM F1667 Standard clearly teaches away from customization or modifications to nails set forth since the Standard already provides for the user, numerous approved nail choices having various dimensions and proportions for each specific application.

Moreover, the nails disclosed in Table 36 of the ASTM F1667 Standard are shingle nails, which are non-structural nails that cannot be used for structural applications such as for sheathing as required by the claims. In this regard, the nail identified by the Examiner as having the dimensions of the recited nail of claim 1 is made from aluminum. Moreover, the nail identified by the Examiner from Table 36 is specifically disclosed in Table 36 as having a smooth shank, and does not have a plurality of surface deformations as specifically recited in claim 1. Thus, these substantial differences further teach away from the present invention or the combination now suggested by the Examiner. Clearly, there is no motivation for a

person of ordinary skill in the art to modify a nail, such as that disclosed in Shelton, to have modified dimensions of another non-structural nail that is approved for use in a completely different application, and made of a completely different material, such as the shingle nail disclosed in Table 36 of the ASTM F1667 Standard.

Thus, in view of the above, the Applicants respectfully contend that the Examiner has failed to establish a *prima facie* case of obviousness in that he has not established any motivation, whatsoever, for modifying the nail disclosed in Shelton to have the dimensions of an unrelated, non-structural, smooth shank, aluminum shingle nail disclosed in Table 36 of the ASTM F1667 Standard. Correspondingly, the withdrawal of this rejection, and the allowance of independent claim 1, as well as the allowance of claims dependent thereon, are respectfully requested.

Moreover, the Examiner also fails to establish how the combination of the recited references render other various dependent claims obvious. For example, claims 3 and 4 both recite specific length dimensions which are not disclosed at all in Table 36 of the ASTM F1667 Standard. Claims 8 and 9 recite frangible plastic binding element and wire weld, respectively, both of which are also not disclosed by the combination of the cited references.

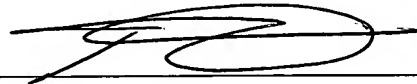
Referring again to the Office Action, the Examiner's specifically rejected independent claims 11 and 20, asserting that because Oswald shows a nail made from steel having a shank diameter in the range of 0.0625 to 0.125 inch, it would have a minimum average bending yield strength of 100 ksi in accordance with NER-272, Section 3.3.2, citing the specification of the present application itself. However, this rejection is believed to be rendered moot in view of the above remarks, and the fact that NER-272 does not cure the deficiencies noted above. In particular, the cited NER-272 reference does not disclose a steel nail suitable for sheathing that has the length dimension as well as the ratio of the head diameter to the shank diameter as recited in independent claims 11 and 20. Therefore, the Applicants again respectfully contend that this rejection is improper, and request the withdrawal thereof.

With respect to the Examiner's rejection of dependent claims 12-19, and 21-25, these rejections are believed to be rendered moot at least for the reason of their dependency upon an allowable base claim. Moreover, various arguments set forth in the above remarks are believed to be equally applicable to these rejected claims as well, these remarks being

omitted to avoid repetition. Correspondingly, the allowance of these claims are also respectfully requested.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. However, if the Examiner deems that any issue remains after considering this response, he is invited to call the undersigned to expedite the prosecution and work out any such issue by telephone.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Tim L. Brackett, Jr.', written over a horizontal line.

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